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AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER WOOD, ELLEN S	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/552,880  
Filing Date: October 12, 2006  
Appellant(s): FRANKHUISEN, JOHN

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Mark D. Passler  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 02/02/2011 appealing from the Office action mailed 03/03/2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1-24 were pending in this application. Claims 1-24 stand rejected.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

WO91/16025	Samonides et al.	10-1991
JP10-180970	Akio et al.	07-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 24, the applicant claims "**wherein the outer layer is paper**". The claim is dependent from claim 18 which is dependent from claim 16. Claim 16 claims an outermost layer but does not describe an outer layer. Does the "outer layer" comprise a multi-layer laminate? Where is the outer layer positioned within the laminate?

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4-11 and 15-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Samonides (WO 91/16025).

In regards to claims 1 and 23, Samonides discloses a pre-printed label. The label consist of a carrier sheet (outer layer), may be a white kraft paper (pg. 13 ¶1). Thus, the outer layer has an opacity. A transparent face sheet (under layer) is extruded onto the carrier sheet (pg. 13 ¶3). The face sheet has been described as transparent but the film may be opaque (pgs. 14-15 ¶3). It would be inherent that when a paper layer is exposed to moisture or liquid the opacity would reduce, however when a polyolefin is exposed to moisture or liquid the opacity would retain, because paper absorbs moisture or liquid, wherein polyolefin materials repel moisture or liquid.

In regards to claims 2, Samonides discloses that the face sheet is adhered to the carrier sheet and the face sheet being a film of plastics (pg. 13 ¶3).

In regards to claim 4, Samonides discloses that the carrier sheet is secured to the face sheet by a permanent adhesive (pg. 13 ¶3).

In regards to clam 5, Samonides discloses that the face sheet is a stable laminate base (pg. 4 ¶1).

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In regards to claims 6-7, Samonides discloses that the first or bottom surface of the pressure-sensitive adhesive layer may be adhesively affixed to another surface, such as the surface of a container or the like (pg. 4 ¶4). The examiner considers this the innermost surface.

In regards to the claim 8, Samonides discloses a label attached to the outer surface of a container by a glue which is applied to the label when wet and allowed to dry when in situ on the container (pg. 5 ¶2).

In regards to claims 9 and 22, Samonides discloses that the container is a clear bottle (pg. 1 ¶2).

In regards to claims 10-11, Samonides discloses that the face sheet is formed of a polyester resin, or polypropylene, or polyethylene (pg. 13 ¶3).

In regards to claim 15, Samonides discloses that the face sheet is extruded on top of the printing, and the composite is then pressed between form rolls (pg. 13 ¶3). The outer layer is being joined to the under layer onto a sheet of extruded plastics material.

In regards to claims 16-17, Samonides discloses an outermost label wherein a pressure sensitive adhesive layer has printed label indicia which is then covered by a thermoplastic protective cover (pg. 4 ¶1). The pressure-sensitive adhesive layer is applied to smooth surface, such as a bottle (pg. 4 ¶1), thus, an innermost layer that is coupled between the outermost layer and the bottle. The protective cover and the adhesive may be an opaque material (pg. 15 ¶1).

In regards to claim 18, Samonides discloses that the pressure-sensitive adhesive is preferably a water-based, acrylic adhesive and may be colorless or tinted (pg. 10 ¶4). The formula for the acrylic adhesive includes acrylate polymer (pg. 10 ¶4), thus a plastics material.

In regards to claims 19-20, Samonides discloses the laminate formed through extrusion (pg. 14), which is a water insoluble means and fusion of plastics material.

In regards to claim 21, Samonides discloses that the label has a pressure-sensitive adhesive layer, preferably a water-based acrylic adhesive (pg. 3 ¶ 3). Printed label indicia is applied to the pressure-sensitive adhesive layer and a thermoplastic protective cover layer covers the printed indicia and is irremovably affixed to the second or top surface of the pressure-sensitive adhesive layer, which is the surface carrying the printed label indicia (pg. 4 ¶ 1). The first or bottom surface of the pressure-sensitive adhesive layer may be adhesively affixed to another surface, such as the surface of a container or the like, and the printed indicia will be visible (pg. 4 ¶ 1).

In regards to claim 24, Samonides discloses a carrier sheet 4 that consists of a white kraft paper (pg. 13 ¶1). This is considered an outer layer of paper (fig. 2).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samonides (WO 91/16025).

Samonides discloses the label of laminate construction as previously discussed. Smith is silent with regards the level of opaqueness of the polypropylene plastic.

Samonides discloses that a transparent face sheet (under layer) is extruded onto the carrier sheet (pg. 13 ¶3). The face sheet has been described as transparent but the film may be opaque (pgs. 14-15 ¶3) so that the label indicia which has been printed on the adhesive layer at the interface with the face sheet is visible through the adhesive and through the underside of the label (pg. 15 ¶3). This is desirable where the label is applied to a clear bottle (pg. 15 ¶3).

It would be obvious to one of ordinary skill in the art to use an appropriate level of opaqueness of the white face sheet when applying the label to a glass bottle, because the white face sheet and level of opaqueness provides the printed indicia to appear when the label is wet.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 10, 15 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Akio (JP 10-180970).

In regards to claim 1, Akio discloses an opaque layered product [0005]. The layered product is considered a laminate construction. The layered product comprises a surface layer of pulp paper (outer layer) and a opaque support layer (under layer)[0005]. The opaque support layer is formed from opaque vegetable pup paper, an opaque plastic film, a metallic film, etc. [0005]. The pulp paper is laminated to the opaque film [0022]. Thus, the under layer is attached to the outer layer. A color picture is recorded on the pulp paper [0023]. The laminate of Akio is considered a label, because the broadest reasonable interpretation would define a label as a printed surface.

The limitation in claim 1 of, “wherein the opacity of the outer layer material reduces after the outer layer is exposed to moisture or liquid” is functional language of just the outer layer material and does not give rise to the function of the label. Thus, if the prior art structure is capable of performing the function of the label then it meets the claim.

In regards to claim 2, Akio discloses that the opaque support layer is formed from opaque vegetable pup paper, an opaque plastic film, a metallic film, etc. [0005].

In regards to claim 3, Akio discloses that the PET film is white [0022].

In regards to claim 4, Akio discloses that the opaque base material is adhered to the pup paper through a permanent adhesive [0012].

In regards to claim 5, Akio discloses a base material [0005]. This is considered a stable laminate base. Additionally, it should be noted that it has been held that the

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recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

In regards to claim 6, Akio discloses a base material adhered to a surface layer [0012]. Thus, the base material is adapted to adhere to the surface layer. Additionally, it should be noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

In regards to claim 10, Akio discloses that the opaque base material can be a plastic film or polyester, polyethylene and polypropylene [0005].

In regards to claim 15, Akio discloses that the outer layer is joined to the under layer by being applied directly onto a sheet of extruded plastics material [0012].

In regards to claim 23, Akio discloses that the outermost layer is paper [0005].

### **(10) Response to Argument**

The examiner would like to state that the appellant did not address the 112, second paragraph, rejection of claim 24. Claim 24 does not provide antecedent basis for the claim language "outer layer".

In viewing the claims of the case it is important to give the claims the broadest reasonable interpretation. The examiner would like to note that the claims do not recite a label that has been adhered to a surface. The independent claim 1, states "a label of

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laminate construction". According to dictionary.com, the definition of label when used as a noun is given as:

1. a slip of paper, cloth or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc.

Thus, when viewing the prior art a "label" is a slip that has a type of indicia, wherein the label has yet to be attached to an article.

The applicant argues that Samonides discloses a first embodiment of a label that includes a carrier sheet 4 that does not form part of the finished label (Appeal Brief, pg. 10 lines 3-6). The applicant states that the composite carrier sheet 4 is removed from the adhesive backed label once the label is in place. The carrier merely acts to carry the label prior to application.

In response, as previously stated, the claims are not directed to a label that has been adhered to a substrate. The label as claimed by the applicant is merely a slip of a laminate construction that is formed for attachment to something. Samonides discloses a first embodiment of a label that has been printed with a printed press used to print tags and labels (pg. 8 lines 1-3). The press uses a carrier sheet to form the laminate construction of the label. The carrier sheet is passed through several guide rolls where an adhesive layer 22 is extruded onto the carrier sheet (pg. 8 ¶3). The composite is then moved through seven printing stations, wherein printed label indicia 28 is applied to adhesive layer 22 (pg. 9 ¶2). After the printing operation has been completed the composite is then guided through a second extrusion station, in which a hot molten

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resin, such as polyethylene or polypropylene, is extruded onto the composite sheet (pg. 9 ¶2). Thus, the carrier sheet is part of the label before adherence onto a substrate.

The examiner would like to direct the attention back to the claim language of independent claim 1. The claim states “an outer layer for receiving printed indicia on an exposed surface thereof”. The carrier sheet of Samonides is an outer layer that is used for receiving printed indicia. The carrier sheet of Samonides is exposed when the printed indicia is printed thereon. Thus, the carrier sheet of Samonides meets the limitations of the outer layer of the claims. The examiner would also like to note that the claim language for the outer layer is an intended use of the outer layer. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The applicant argues that the pulp paper-containing opaque laminated body of Akio is not a label.

In response, the examiner would like to stress once again that the label of the applicant's claimed invention has yet to be adhered to a surface. Thus, when looking at the prior art a surface that has a printed indicia contained on a surface thereof would be considered a label. The paper of Akio is a laminate structure, wherein a color picture is recorded thereon [0023]. The label of the applicant's claimed invention does not claim adhesive properties within the actual laminate structure of the label. Thus, a piece of

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paper can be considered a "label", because a piece of paper can be applied to a surface. Thus, meeting the requirements of the applicant's claimed label.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ELLEN S WOOD/

Examiner, Art Unit 1782

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